

Kindly enter the following amendment:

***In the Claims:***

Please amend Claims 3, 7, and 11 as follows:

Claim 3, line 1, replace "2" with --1--.

Claim 7, line 1, replace "6" with --5--.

Claim 11, line 1, replace "10" with --9--.

**Remarks**

Claims 1, 3-5, 7-9, and 11-12 are presented to the Examiner for reconsideration. By the foregoing Amendment, Claims 3, 7, and 11 are sought to be amended. These changes are believed not to introduce new subject matter, and their entry is respectfully requested.

Based on the above Amendment and the following Remarks, which are supported by the concurrently submitted original, executed Declaration under 37 C.F.R. § 1.132 (accompanied by Exhibits 1 and 2), Applicants respectfully request that the Examiner reconsider and withdraw all outstanding rejections.

***I. Rejections of Claims under 35 U.S.C. § 103***

The Office Action indicates that Claims 1, 3, 4, 9, 11, and 12 were rejected under 35 U.S.C. § 103 as being allegedly unpatentable over U.S. Patent No. 4,991,037 to Shimizu *et al.* ("Shimizu") in view of U.S. Patent No. 4,399,959 to Godsoe *et al.* ("Godsoe") and further in view of the three U.S. patents to Moy *et al.* ("Moy"). (See, Office Action, paragraphs 1 and 3.) The Office Action also indicates that Claims 5, 7, and 8 are rejected under § 103 as being allegedly unpatentable over Shimizu in view of Godsoe and Moy. (See, Office Action, paragraphs 2-3.)

Applicants respectfully disagree with the Office Action contentions and maintain that the rejections are improper. (*See*, Response and Amendment under 37 C.F.R. §§ 1.111 and 1.116, filed December 19, 1994 ("Response"), pages 6-9.) As discussed in the Response, the claimed invention, as a whole, teaches a *helical scan transport* for a *single reel tape cartridge* with a *form factor* (*i.e.*, physical dimensions and layout) fully compatible with its predecessor longitudinal tape transports currently in market, such as the Storage Technology Corporation ("StorageTek") 4400 Automated Cartridge System. (*See*, Specification, page 5, lines 13-20.) This combination of claimed features is neither taught nor suggested by the art of record.

Assuming, *arguendo*, that a *prima facie* case of obviousness has been made, Applicants further submit that the rejections are traversed by the overwhelming commercial success of an embodiment of the claimed invention as evidenced by the concurrently submitted Declaration. The Supreme Court, in its seminal decision, held that not only must the factual inquiries of determining the scope and content of the prior art, the differences between the prior art and the claims, and the level of ordinary skill in the pertinent art accompany any obvious analysis, but also *indicia* of "secondary considerations," including commercial success, have relevancy. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

Indeed, evidence of "secondary considerations" may often be "the most probative and cogent evidence in the record." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538, 218 USPQ 871, 879 (Fed. Cir. 1983). As such, "secondary considerations" must be considered as part of all the evidence. *See, e.g., Simmons Fastener Corp. v. Illinois Tool Works Inc.*, 739 F.2d 1573, 222 USPQ 744 (Fed. Cir. 1984). In *Simmons*, the Federal Circuit *agreed* with the trial court that "the teachings of the prior art *prima facie* would have suggested to one of ordinary skill in the art the claimed invention." *Simmons*, 739 F.2d at 1575-1576, 222 USPQ at 747. Notwithstanding such a finding, however, the Federal Circuit *reversed* the lower court and in doing so found that the invention was patentable because of secondary considerations. Moreover, immediate and substantial commercial success may be given substantial weight when a *nexus* between the merits of the claimed invention and the offered evidence clearly exists. *Sjolund v. Musland*, 847 F.2d 1573, 6 USPQ2d 2020 (Fed. Cir. 1988); *Cable Elect. Prod., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 226 USPQ 881 (Fed. Cir. 1985); *Cf. Newell Cos., Inc. v. Kenny Mfg. Co.*, 864 F.2d 757, 9

USPQ2d 1417 (Fed. Cir. 1988), *cert. denied*, 493 U.S. 814 (1989); *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 21USPQ2d 1053 (Fed. Cir. 1991).

Accordingly, the Court of Appeal for the Federal Circuit ("Federal Circuit") has consistently held that objective evidence of "secondary considerations" must always be taken into account and "not just when the decisionmaker [sic] remains in doubt after reviewing the art." *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1538-1539, 218 USPQ 871, 879 (1983); *The Gillette Co. v. S.C. Johnson & Son, Inc.*, 919 F.2d 720, 16 USPQ2d 1923 (Fed. Cir. 1991); *Minnesota Mining and Mfg. Co. v. Johnson & Johnson*, 976 F.2d 1599, 24 USPQ2d 1321 (Fed. Cir. 1992); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986). Thus, the consideration of commercial success as evidence is not discretionary, but rather mandatory. Indeed, it is an error to exclude such evidence en route to a determination on obviousness. *Stratoflex*, 713 F.2d at 1539, 218 USPQ at 879.

The extraordinary commercial success and industry embracement of an embodiment of the claimed invention, the StorageTek RedWood™ SD-3 Helical Scan Transport ("RedWood"), further support Applicants' position that the present invention would not have been obvious to one of ordinary skill in the art. (*See*, Declaration, paragraphs 1-4 and 8-11.) In accordance with the claimed invention, the RedWood is a *helical scan tape transport* for a *single reel tape cartridge* with a *form factor* fully compatible with its predecessor longitudinal tape transports (*e.g.*, the StorageTek Timberline™ (36-track), Silverston™ (36-track), and model 4480 (18-track)). (*See*, Declaration, paragraphs 1-4.) As such, the RedWood *form factored* solution provides several significant advantages over the transport solutions of StorageTek's competitors, including full automated library compatibility, enhanced user versatility, and low-cost-of-ownership benefits. (*See*, Declaration, paragraphs 5-7.)

In fact, the actual and projected sales of the RedWood are meeting or exceeding expectations of both StorageTek and data processing industry analysts alike. (*See*, Declaration, paragraphs 8-9.) Correspondingly, StorageTek now projects that the RedWood will acquire a 5% share of all transports sales as early as March 1996, which is only 13 months from its commercial announcement. (*See*, Declaration, paragraph 8.)

By comparison, the current leading supplier of dual reel helical transports, E-Systems Inc., has only acquired approximately a 2-4% market share over the more than 24 months since its 1993 introduction. (See, Declaration, paragraph 9.) While StorageTek forecasts that RedWood's commercial success will motivate its competitors to follow suit and attempt to provide *form factored* transports for *single reel helical tape cartridges*, it is not expected that any such competitors' products will be on the market for at least several years due to the significant development and tooling efforts involved. (See, Declaration, paragraph 16.)

The data processing industry's high expectations for the RedWood are also evidenced by the significant commitments and increasing interest of worldwide tape cartridge manufacturers, including 3M Inc. and other major tape manufacturers in Europe and Japan. (See, Declaration, paragraph 10.) In addition, acceptance of the RedWood solution is evidenced by the adoption by the European Computer Manufacturers Association (ECMA) of the SD-3 recording standard format and tape interchange used with the RedWood. Similar standard proposals are currently before the American National Standards Institute (ANSI) and the International Organization for Standardization (IOS). (See, Declaration, paragraph 11.)

This extraordinary commercial success and industry acceptance of the RedWood is not the result of heavy promotion or advertisement, market demands, or any other extraneous business, but rather is materially attributable to the merits of the claimed invention (*i.e.*, a *helical scan transport* for a *single reel tape cartridge* with the *form factor* feature) and its corresponding advantages (*e.g.*, compatibility, versatility, and low-cost-of-ownership). (See, Declaration, paragraphs 12-15.) Since such a clear *nexus* does exist, it is proper for such evidence to be given significant weight in an obviousness analysis.

Applicants thus respectfully submit that the evidence presented properly rebuts any *prima facie* showing of obviousness presented in the Office Action, or any other plausible argument based on the art of record. Accordingly, for at least these reasons, Applicants submit that independent Claims 1, 5, and 9 and Claims 3-4, 7-8, and 11-12 dependent thereon are patentable over the art of record and respectfully request consideration and withdrawal of the rejections.

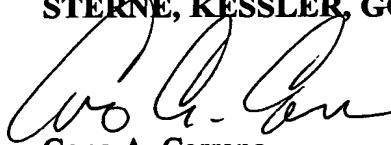
### Conclusion

Claims 1, 3-5, 7-9, and 11-12 are presented to the Examiner for reconsideration. Applicants believe that these claims are allowable based on the Amendment and Remarks set forth above, along with the concurrently submitted original, executed supporting Declaration (accompanied by Exhibits 1 and 2), and therefore respectfully request reconsideration and withdrawal of all presently outstanding rejections.

The Examiner is invited to telephone the undersigned representative, if it is believed that an interview might be useful for any reason.

Respectfully submitted,

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